

**REMARKS**

The Office Action mailed July 14, 2005 has been carefully considered. Within the Office Action Claims 1-3, 11 and 12 have been rejected and Claims 4-10 and 13-20 have been objected to. The Applicants have amended Claims 2, 4, 5, 7, 8, 10, 11, 14, and 16-20 and have cancelled Claim 1. The Applicants reserve the right to further pursue the cancelled claim in continuation and/or divisional applications as well as for appeal purposes. In addition, the Applicants have added new Claim 21. Accordingly, Claims 2-21 are currently pending. Reconsideration in view of the above amendments and following remarks is respectfully requested.

**Formal Drawings**

The Applicants have submitted formal drawings for Figures 1-4 with the present response. The drawings do not add new matter and are fully supported by the specification. The Applicants respectfully request consideration of the formal drawings.

**Rejection under 35 U.S.C. § 103**

Claims 1-3, 11 and 12 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,057,980 to Todd et al. (hereinafter Todd) in view of U.S. Patent No. 5,867,352 to Dohmen (hereinafter Dohmen). Specifically, the Office Action contends that the elements of the presently claimed invention are disclosed in Todd except that Todd does not teach a read/write head with grooves. The Office Action further contends that Dohmen discloses a read/write head with grooves and that it would be obvious to one having ordinary skill in the art at the time of the invention to incorporate Dohmen into Todd in order to reach the present invention(s). The Applicants respectfully traverse for the reasons set forth below.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

See M.P.E.P. 2141. In addition, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See M.P.E.P. 2141.02; See also *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

It is stated in the present specification that during the cleaning operation, in an embodiment, the brush 16 is moved downward toward the second axial end of the read/write head 12 to sweep debris off of the head 12. Upon the debris being swept from the read/write head, the brush 16 is then moved in an upward direction to again sweep the read/write head. The bi-directional movement of the brush in the cleaning cycle thus allows thorough cleaning of the read/write head.

In contrast, Todd expressly discloses that once the shuttle 34 pulls the cartridge 12 approximately 1 inch into the deck 54, the head cleaner mechanism 68 swipes across the read/write head 126. (Todd, Col. 4, Lines 22-25). The head cleaner mechanism 68 includes a head cleaner linear slide 72 which is actuated by the rotary drum 74 with a helical path 76 therein. (Todd, Col. 4, Lines 25-27). The head cleaner mechanism 68 moves the cleaning brush 70 across the read/write head 126 once during each load/unload sequence. (Todd, Col. 4, Lines 27-31) (emphasis added).

One skilled in the art would have no motivation to combine Todd and Dohmen to reach the present invention. Claims 2 and 11 as amended each recite, among other things, that the brush is moved along the read/write head along a first direction and a second opposite direction in a cleaning cycle. However, Todd does not teach, hint or suggest that the cleaning brush is moved in a first and a second opposite direction during the cleaning cycle. In fact, Todd teaches away from this notion by expressly stating that the cleaning brush is moved across the read/write head once during the loading or unloading of the magnetic tape. Considering that Todd must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention (See M.P.E.P. 2141.02), one skilled in the art would have no motivation to combine Todd and Dohmen in reaching the invention(s) in Claims 2 and 11. For at least these reasons, Claims 2 and 11 are patentable over Todd and Dohmen, individually or in combination.

Claims 3 and 12 have also been rejected in light of Todd and Dohmen. However, Claim 3 is dependent on Independent Claim 2 and Claim 12 is dependent on Independent Claim 11. As stated above, Claims 2 and 11 are allowable over Todd and Dohmen. Accordingly, Claims 3 and 12 are allowable for being dependent on allowable base claims.

#### New Claims

The Applicants have added new Claim 21 to the present application. It should be noted that new Claim 21 is fully supported by the specification and no new matter has been added. Claim 21, among other things, recites a cleaning element which cleans the read/write head along the first axis in a first direction and a second opposite direction. As stated above, Todd teaches away from this notion and one skilled in the art would thus have no motivation to combine Todd and Dohmen to reach the invention recited in Claim 21. For at least these reasons, Claim 21 is

patentable over Todd and Dohmen, individually or in combination. Accordingly, allowance of new Claim 21 is respectfully requested.

Conclusion

It is believed that the amendments and remarks place the above-identified patent application into condition for allowance. Early favorable consideration of the present application is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,

THELEN REID & PRIEST, LLP

A handwritten signature in black ink, appearing to read 'S. Bhattacharya', written over a horizontal line.

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